

## REMARKS

Reconsideration of this application, as amended, is respectfully requested. The following remarks are responsive to the Office Action mailed March 14, 2001.

Claims 1-69 are pending.

Claims 1, 2, 4, 5, 6, 9, 10, 12, 14, 17, 18, 20, 21, 22, 25, 26, 28, 30, 33, 34, 36, 37, 38, 41, 42, 44, 46, 49, 50, 52, and 53 have been amended to improve form. New claims 56-69 have been added. Applicant respectfully submits that the amendments made herein do not add new matter.

Claims 1, 5-9, 13-17, 21-25, 29-33, 37-41, 45-49, 53-55 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,890,138 to Godin (“Godin”).

Claims 2-4, 10-12, 18-20, 26-28, 34-36, 42-44, 50-52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Godin.

### 35 U.S.C. § 102(e) Rejection

The Examiner has rejected claims 1, 5-9, 13-17, 21-25, 29-33, 37-41, 45-49, and 53-55 under 35 U.S.C. 102(e) as being unpatentable over Godin. Claims 1, 5, 6, 9, 14, 17, 21, 22, 25, 30, 33, 37, 38, 41, 46, 49, and 53 have been amended. Applicant respectfully submits that Godin fails to teach, suggest, or render obvious the present invention as claimed.

Independent claims 1, 17, and 33, as amended, recite, *inter alia*, “responsive to said detection of said selection of said one category entry, displaying at least one subcategory field in said display window, said at least one subcategory field containing a plurality of subcategory entries used to categorize said item in said auction, said plurality

of subcategory entries corresponding to said one category entry of said plurality of category entries."

Independent claims 9, 25, and 41, as amended, recite, *inter alia*, "responsive to said detection of said selection of said category entry, providing a plurality of subcategory entries corresponding to said selected category entry, to be displayed for said user in at least one subcategory field within said display window, said plurality of subcategory entries being used to categorize said item in said auction."

Independent claim 49, as amended, recites, *inter alia*, "responsive to said detection of said selection of said one category entry, to determine whether said database contains a plurality of subcategory entries corresponding to said one category entry and being used to categorize said item in said computerized auction and to provide said plurality of subcategory entries to be displayed for said user in at least one subcategory field within said display window."

The Office Action asserts that Godin teaches essentially all of the limitations of claims 1, 5-9, 13-17, 21-25, 29-33, 37-41, 45-49, and 53-55. Applicant respectfully disagrees for the following reasons.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Godin discloses a system and method for providing rapid feedback of a reverse auction process and for removing a user from the process once an indication to purchase

has been received. Godin fails to teach or suggest that at least one subcategory field is displayed in a display window, the at least one subcategory field containing a plurality of subcategory entries used to categorize the item, the plurality of subcategory entries corresponding to the selected category entry, as claimed in independent claims 1, 9, 17, 25, 33, 41, and 49, as amended. Looking at Godin in more detail and addressing the paragraphs cited in the Office Action, Godin teaches at most that category information of upcoming auctions is provided in a screen shown in Figure 7, and that clicking on any category allows the user to review product details in a different screen shown in Figure 8. *See* col. 4, lines 21-25. There is no teaching or suggestion anywhere in Godin of multiple subcategory entries corresponding to a selected category entry being displayed in a subcategory field of the display window that also displays a category field containing the selected category entry.

Therefore, Applicant respectfully submits that independent claims 1, 9, 17, 25, 33, 41, and 49, as amended, are distinguishable over the Godin reference, and claims 5-8, 13-16, 21-24, 29-32, 37-40, 45-48, 53-55, dependent directly or indirectly from claims 1, 9, 17, 25, 33, 41, and 49 respectively, are also distinguishable at least for the same reasons as state above.

#### **35 U.S.C. § 103(a) Rejection**

The Examiner has rejected claims 2-4, 10-12, 18-20, 26-28, 34-36, 42-44, 50-52 under 35 U.S.C. 103(a) as being unpatentable over Godin. Claims 50 and 52 have been amended. Applicant respectfully submits that Godin fails to teach, suggest or render obvious the present invention as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2-4, 10-12, 18-20, 26-28, 34-36, 42-44, 50-52 depend directly or indirectly from independent claims 1, 9, 17, 25, 33, 41, and 49, as amended.

Independent claims 1, 17, and 33, as amended, recite, *inter alia*, “responsive to said detection of said selection of said one category entry, displaying at least one subcategory field in said display window, said at least one subcategory field containing a plurality of subcategory entries used to categorize said item in said auction, said plurality of subcategory entries corresponding to said one category entry of said plurality of category entries.”

Independent claims 9, 25, and 41, as amended, recite, *inter alia*, “responsive to said detection of said selection of said category entry, providing a plurality of subcategory entries corresponding to said selected category entry, to be displayed for said user in at least one subcategory field within said display window, said plurality of subcategory entries being used to categorize said item in said auction.”

Independent claim 49, as amended, recites, *inter alia*, "responsive to said detection of said selection of said one category entry, to determine whether said database contains a plurality of subcategory entries corresponding to said one category entry and being used to categorize said item in said computerized auction and to provide said plurality of subcategory entries to be displayed for said user in at least one subcategory field within said display window."

As discussed in detail above, Godin fails to teach or suggest the above limitation. Therefore, Applicant respectfully submits that claims 2-4, 10-12, 18-20, 26-28, 34-36, 42-44, 50-52 are distinguishable over the Godin reference as well.

In view of the amendments and remarks set forth herein, Applicant also submits that newly added claims 56-69, dependent directly or indirectly from independent claims 1, 9, 17, 25, 33, 41, and 49, as amended, are also patentable and should be allowed. Therefore, Applicant submits that the above 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections have been overcome and respectfully requests the Examiner to find claims 1-69 in condition of allowance.

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Alin Corie at (408) 947-8200.

If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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